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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/780,990	02/09/2001	Richard H. Peters	8500-0258	2254

23980 7590 03/04/2002

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EXAMINER

QAZI, SABIHA NAIM

ART UNIT PAPER NUMBER

1616

DATE MAILED: 03/04/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/780,990

Applicant(s)

Richard H. Peters et al.

Examiner

Sabiha Qazi

Art Unit

1616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Feb 9, 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-44 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claims 1-44 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some\* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_
- 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

***Election/Restriction***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-5 are drawn to the compounds of formula (I), classified in class 552, subclass 627+.
- II. Claims 6-13 are drawn to the compounds of formula (III), classified in class 552, subclass 627, 652 +.
- III. Claims 14-18 are drawn to the compounds of formula (V), classified in class 552, subclass 625+.
- IV. Claims 19 is drawn to the compounds of formula (XVII), classified in class 552, subclass 626+.
- V. Claims 20, 36 and 40 are drawn to the composition, compounds of formula (XVIII), and the method for treatment, classified in class 552, subclass +.
- VI. I Claims 21, 37 and 41 are drawn to the composition, compounds of formula (VII), and method for treatment, classified in class 514, subclass 182; class 552, subclass 627+.
- VII. Claims 22-25 are drawn to the compounds of formula (XVI), classified in class 514, subclass 178, 182; class 552, subclass 652, 627+.
- VIII. Claims 26 is drawn to the method for synthesizing 21-hydroxy-19-nor pregnane of formula 1, classified in class 552, subclass 618, 619, 627+.
- IX. Claims 27 is drawn to the method of preparing 21-hydroxy-19-nor pregnane comprising formula (IX), classified in class 552, subclass 618, 619, 627+.
- X. Claims 28 is drawn to the method of preparing 7-alkyl-6-keto-1,3,5(10) estratriene, classified in class 552, subclass 627, 652.
- XI. Claims 29 is drawn to the method of preparing 7-alkyl-6-keto-1,3,5(10) estratriene of formula (VIa), classified in class 552, subclass 627, 652.

XII. Claims 30, 31 are drawn to the method for preparing compound of formula (XI), classified in class 552, subclass 627, 652.

XIII. Claims 32, 33 are drawn to the method for preparing compound of formula (XI), classified in class 552, subclass 627, 652.

XIV. Claims 34, 35 are drawn to the method for preparing compound of formula (XI), classified in class 552, subclass 627, 652.

XV. Claims 38 and 42 are drawn to the composition and method for treatment, classified in class 514, subclass 178, 182.

XVI. Claims 39 and 43 are drawn to the composition and method for treatment, classified in class 514, subclass 178, 182.

XVII. Claims 44 is drawn to the method of preparing, classified in class 552, subclass 627, 615, 625, 626, 652.

The inventions are distinct each from the other because of the following reasons:

1. The groups I-XVII as outlined above are drawn to the invention which require separate searches, and are not art recognized equivalents. They are patentably distinct.

2. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Burden is likewise demonstrated by divergent subject matter and separate database search for the entire genus would represent excessive burden on the examiner.

3. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species from the elected group, even though this requirement is traversed.

4. A telephone call was made to Attorney Dianne Reed on 2/22/02 to request an oral election to the above restriction requirement, but did not result in an election being made. Ms. Dianne requested to send in writing.

5. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventor ship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventor ship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

7. It is suggested that in order to advance prosecution, the non elected subject matter be canceled when responding to this office action.

#### **Telephonic Inquiry**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sabiha N. Qazi, whose telephone number is (703) 305-3910. The examiner can normally be reached on Monday through Friday from 8 a.m. to 6 p.m. The fax phone number for this Group is (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1235.



**Sabiha N. Qazi, Ph.D.**  
**Primary Examiner, 1616**

2/22/02